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REMARKS

In the pending Office Action, Examiner Philogene has initially rejected pending claims 21-30. The Examiner is respectfully requested to reconsider the pending claims in light of the following remarks.

The Office Action first alleged a non-statutory double patenting ground for rejecting claims 21-30. This ground for rejection is not conceded. Respectfully, the comments in the Office Action suggesting that functional language cannot differentiate subject matter is not a sound statement of the law. See MPEP 2173.05(g), *citing Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111 (Fed. Cir. 2004). A terminal disclaimer is enclosed to obviate this rejection, and accordingly this double patenting rejection should be withdrawn.

The Office Action alleged that the Lin reference (U.S. Patent No. 5,575,791) anticipated claims 21-22 and 25-30. An anticipating reference must show all features of the claim, arranged as the claim dictates. MPEP 2131. The Office Action alleged that item 30 of Lin corresponded to the "compressible ring" of claim 21, and that Lin's item 40 was the claim's "collet."

Respectfully, it appears that the Examiner has transposed features in the Lin reference in making this rejection. Claim 21 places a "bone anchor" through a "collet" in two channels of a clamp. The Lin reference, on the contrary, shows a rod through two channels of a clamp. In other words, these claims define positioning of the rod and anchor with respect to the clamp that is opposite to the positioning shown in Lin. Even if it could be said that all of the features of claim 21 are shown in the Lin reference, such features are not arranged as they are in claim 21, and thus the Lin reference cannot anticipate that claim.

Dependent claims 22-30 are not anticipated by the Lin reference at least because of their dependence from claim 21. The Office Action acknowledges that the Lin reference does not have all of the features of claims 23 and 24, and several other claims are also allowable over Lin on their own merit. For example, the "collet" identified in claim 22 is an item that defines a socket to hold a vertebral anchor.

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The only part of the Lin reference that holds its screw 60 is its "eccentric collar" 30. That collar does not have a threaded end, nor is a nut engaged to it. The Lin reference thus does not show a collet or nut as defined and arranged as in claim 22.

Claim 25 recites that the claimed compressible ring (which has an aperture for a rod, per claim 21) have at least a partially spherical exterior, and that the channel of the recited clamp have a substantially mating concave surface. The only parts of Lin that have an aperture for a rod are parts 40, 40', 40'' and 40''', and as seen in its Figures 3-6, those items have linear, block or tapered exteriors, not a partially spherical exterior. As seen in Lin's Figures 1a and 1b, the only part of Lin that could be reasonably compared to the recited channel, Lin's item 11, does not have a mating surface, and given the squared phantom lines, it does not appear to have a concave surface. None of the language or figures referred to in the Office Action (page 4, lines 1-2) disclose or suggest these features in Lin's item 40.

Claim 26 recites a collet that has three or more slots near an end. As already discussed, its item 30 is the only part of Lin that could be compared to the recited collet. However, the Lin reference clearly shows that its item 30 has only one "slit" 31. None of the language or figures referred to at page 4, lines 1-2 of the Office Action disclose or suggest multiple slots in item 30.

To briefly summarize, it is clear that independent claim 21 is not anticipated by the Lin reference, and as the examples above show, its dependent claims 22-30 are also not anticipated because of their dependence and/or on their own merit. It is respectfully requested that the Lin reference and the rejections based on it be withdrawn.

The Office Action rejected claims 23 and 24 as allegedly obvious over a combination of the Lin reference and U.S. Patent No. 6,030,388 to Yoshimi et al. It is respectfully requested that this obviousness rejection be withdrawn for several reasons. First, as already discussed, the Lin reference does not show all elements of claim 21. The combination of Lin and Yoshimi, as discussed in the Office Action, thus does not show or suggest all elements of claims 23 and 24.

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The second reason for withdrawing this rejection is that the Yoshimi reference does not show at least the tapered collet recited in claims 23 and 24. Respectfully, the Office Action does not point to any particular part of Yoshimi as disclosing a tapered collet. There is no item within the "coupling member" 14 of Yoshimi that is around its bolt, and the washer and nut do not have a tapered interior or exterior (see, e.g., Figures 5a and 5b of Yoshimi). Further, it appears that the Office Action's characterization of Yoshimi as using a clamp is at least part of the basis for the rejection, and yet there is no suggestion in Yoshimi that it shows a clamp. Its "coupling member" 14 is not a clamp, but is rather a block with an opening for a rod and an opening for a bolt, and a washer and nut rest around the bolt and on the coupling member.

Third, there is no proper motivation to combine the references. The only apparent statement concerning a possible motivation is that one would look to Yoshimi "to prevent further insertion of the collet into the channel of the clamp." The only part of Yoshimi that performs a "prevent further insertion" function is the medial head of the Yoshimi bolt (see column 7, lines 22-25), which prevents insertion beyond a certain point into the coupling member 14. Thus, the proffered statement concerning motivation to combine does not refer to a collet, but to the head of a bolt. Moreover, the Lin reference relies on an unimpeded insertion of its screw 60 through its item 30 so that a proper height of a clamp above a bone can be maintained. Item 30 is squeezed around screw 60 in a radial fashion to lock item 30 and screw 60 together, and item 30 can connect to screw 60 at many places along screw 60. In Yoshimi, on the other hand, the connection between its coupling member 14 and its bolt must occur at only one place, i.e. where the coupling member rests on the medial head of the bolt, and the force to lock them together is provided by a nut and is directed along the axis of the bolt, not radially. The motivation identified in the Office Action is simply inapplicable to Lin because the mechanisms of Lin and Yoshimi work entirely differently. Without a motivation to combine, no *prima facie* case of obviousness can be established. MPEP 2142.

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Similarly, a fourth reason to withdraw this obviousness rejection is that Lin teaches away from a tapered clamp interior and collet exterior. An important part of the Lin device is the ability of the screw 60 within item 30 to be "adjusted freely as desired." (See, e.g., column 4, lines 61-67.) The reason the Lin device operates in that way is that item 30 includes a rounded exterior (see Fig. 2), enabling item 30 and the screw 60 in it to pivot or twist within Lin's item 20 around a range of angles and in a range of directions. Without that rounded exterior, the Lin device could not work as disclosed in the reference. One of ordinary skill would recognize from Lin's disclosure the importance of that rounded exterior, as well as the disadvantage of changing it, and would not be motivated to make the change the Office Action proposes. In other words, Lin's teaching of a rounded item 30 for free adjustment teaches away from changing item 30 to a configuration that would allow less adjustment. Since the item in Lin comparable to the claimed collet is designed to allow polyaxial positioning of the anchor relative to the clamp and rod, it would not be logical to include such tapered surfaces that lock to each other.

Respectfully, the Lin reference does not anticipate any of the pending claims, and no prima facie case of obviousness has been provided from the Lin and Yoshimi references. With the enclosed terminal disclaimer, all of the objections have been obviated, and the claims should be passed to allowance.

New claims 31-34 are offered, as noted above. Support for them is found throughout the application, such as in paragraphs 0020 and 0024 in the application as published and associated drawings including Figures 2 and 6. These new claims are dependent from claim 21, and are allowable based on that dependence and on their own merit, since neither Lin nor Yoshimi shows or suggests the subject matter in these new claims. No new matter has been added.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the Office Action's rejections, but are simply provided to address the Office Action's rejections in the most expedient fashion. Applicant reserves the right to contest positions taken by the examiner that are not specifically addressed herein. No amendments have been

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made to the claims, and it is intended that the claims herein have the full scope permitted by their language, including a full range of equivalents.

In conclusion, Examiner Philogene is respectfully requested to reconsider this application as amended and in light of the foregoing remarks, and a Notice of Allowance in this case is hereby respectfully requested. The examiner is invited to call the undersigned attorney if there are any further issues to be resolved.

Respectfully submitted,

By



Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Bank One Center Tower, Suite 3700
111 Monument Circle
Indianapolis, Indiana 46204-5137
(317) 634-3456 telephone
(317) 637-7561 facsimile

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